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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,992	08/06/2003	James G. McErlean	103864.139US1	7424
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WILMERHALE/NEW YORK			EXAMINER	
399 PARK AVENUE			DESAI, HEMANT	
NEW YORK, NY 10022				
			ART UNIT	PAPER NUMBER
			3721	
			NOTIFICATION DATE	DELIVERY MODE
			12/12/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.matthews@wilmerhale.com

Office Action Summary

Application No.

10/634,992

Applicant(s)

MCERLEAN ET AL.

Examiner

Hemant M. Desai

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23,30-51 and 72-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23,30-51 and 72-105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, 45-49, 73-75, 78-80, 83-85, 87, 89-91 and 94-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (4988255) in view of Peres (3739471).

Hoffman discloses an automated system for emptying contents of pharmaceutical containers (6, fig. 1), comprising a gripper unit (3, 12, fig. 1) for receiving and holding the container (6), a cutter (47, 48, fig. 5) for cutting the pharmaceutical container, a rotating unit (guide 79-80, fig. 9) operable with the gripper unit (12) that rotates at least a portion of the gripper unit to empty the contents of the container.

Hoffman, as mentioned above discloses the cutter to cut the seal (aluminum foil) to empty the container. Hoffman does not disclose to cut at least one of the top, sidewall or bottom of the container to empty the container. However, Peres discloses that it is well known the art of emptying the containers to cut the top (95) of the container (see col. 4, lines 38-55) to empty the container. The substitution of one known element (the cutter for cut the top as shown in Peres to empty the container) for another (the cutter to cut the seal to empty the container as shown in Hoffman) would have been obvious to

one of ordinary skill in the art at the time of the invention since the substitution of the cutter to cut the top the closure flaps shown in Peres would have yielded predictable results, namely, to empty the container. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the seal cutter of Hoffman with the top cutter of Peres to cut the top of the container to empty the container.

Regarding claims 2-3 and 43, Hoffman discloses a robot (see col. 3, lines 27-28; col. 6, lines 38-39) for placing the container in the gripper unit.

Regarding claims 7-8 and 45, Hoffman discloses that the contents of the container are emptied into a bulk-up container (see col. 6, lines 3-5).

Regarding claim 10, Hoffman discloses that the cutter comprises a blade (47) that moves in a direction substantially parallel to a belt of the conveyor.

Regarding claims 11 and 46, Hoffman discloses that a rod less air cylinder is used to facilitate movement of the cutter.

Regarding claims 12-14, 34 and 47-48, Peres teaches vacuum to retain and place the cut portion in a waste repository (see col. 5, lines 10-15). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the vacuum and repository as taught by Peres in the modified system for emptying contents of the pharmaceutical containers of Hoffman to retain and place the cut portion in a repository.

Regarding claims 15 and 49, Hoffman discloses a scrap chute (col. 6, lines 11-15) that receives a portion of the pharmaceutical container subsequent to emptying the contents of the pharmaceutical container.

Regarding claim 16, Hoffman discloses that the scrap chute to place the portion the pharmaceutical container held by the gripper unit in a scrap bin (see col. 6, lines 10-15).

Regarding claims 19 and 20, Hoffman discloses that the gripper unit comprises first and second interlocking fingers (side walls of the slots 3).

Regarding claim 30, the modified system of Hoffman, as mentioned above, meets all the claimed limitations of claim 30.

Regarding claims 31-32, Hoffman discloses means for placing and transporting (col. 6, lines 36-40) for placing the container (6) in the means for receiving and holding.

Regarding claim 37, the modified system of Hoffman, as mentioned above, meets all the claimed limitations of claim 37.

Regarding claim 38, Hoffman discloses a rotating unit (79, 80), operable with the gripper and the control system (90) that rotates at least a portion of the gripper unit empty the contents of the container.

Regarding claim 39, Hoffman discloses the control system (90, fig. 1). Therefore a keyboard, control logic, a display, and a processing unit in inherent part of the control system.

Regarding claims 73, 78, 83 and 89 Hoffman discloses that the container is placed in the gripper unit any cotton can be removed.

Regarding claims 75, 80, 85 and 91 Hoffman discloses that the system comprising a pill accumulation chute (see col. 6, lines 3-4).

Regarding claim 87, the modified system of Hoffman, as mentioned above, meets all the claimed limitations of claim 87.

3. Claims 4-6, 33, 44, 72, 77, 82, 88-89 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 3, 32, 43, 1, 30, 37 above, and further in view of McGrath et al. (6494017).

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for a vision system (means for viewing). However, McGrath et al. teach a vision system (3, fig. 20) for rejecting out of shape containers from the conveyors (see col. 4, lines 37-67). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide vision system as taught by McGrath et al. in the automated system for emptying contents of Hoffman for rejecting out of shape containers from the conveyors.

Regarding claim 89, Hoffman discloses that the container is placed in the gripper unit any cotton can be removed.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 1 above, and further in view of Blaimschein (5318420).

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for an ultrasonic cutter. However, Blaimschein teaches an ultrasonic cutter to permit an economical and accurate cutting of work-pieces made of any desired polymers or fiber-reinforced polymers with a high efficiency and a low loss of material.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ultrasonic cutter as taught by Blaimschein in the automated system for emptying contents of Hoffman to permit an economical and accurate cutting of work-pieces with a high efficiency and a low loss of material.

5. Claims 17-18, 35, 50, 76, 81, 86 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Pares, as applied to claims 1, 30, 37 and 87 above, and further in view of Kitamura et al. (5423216).

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for a sensor system to determine when the contents of the container are no longer being emptied. However, Kitamura et al. teaches sensor system (7, fig. 4; comprises a light emitter, see col. 6, lines 67-68; col. 7, lines 1-2) to determine the contents of funnel (4, fig. 4) are no longer being emptied to activate the scrapper assembly (8, fig. 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to determine when the contents of the container are no longer being emptied as taught by Kitamura et al. in the automated system for emptying contents of Hoffman to determine when the contents of the container are no longer being emptied to activate the discharge chute traverse assembly to expose the bottle to the bottle discharge chute.

6. Claims 21-23, 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1, 30 and 37 above, and further in view of Yuyama et al. (6644504).

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for detection system to detect the container is no longer being held by the gripper unit. However, Yuyama et al. teach detection system (sensor 8a, fig. 2a) to detect the container (11, fig. 2a) is no longer being held by the vessel holder (8, fig. 2a). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to detect the container is no longer being held by the gripper unit as taught by Yuyama et al. in the automated system for emptying contents of Hoffman to detect the container is no longer being held by the gripper unit.

Regarding claim 23, Hoffman discloses that the container can be of different shapes and sizes (see col. 2, lines 58-61).

7. Claims 40-42 and 99-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 1 and 37 above, and further in view of Coughlin (2004/0059463).

The modified system of Hoffman, as mentioned above, discloses all the claimed limitations of claims 40-42 and 99-100, except for an indicia reader that interfaces with the control system. However, Coughlin teaches an indicia reader (282, fig. 13), which interfaces with control system (28, figs. 9 and 13) to retrieve the information about pharmaceutical (paragraph 0031). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the indicia reader that interfaces with the control system as taught by Coughlin in the automated system for emptying contents of Hoffman to retrieve the information about pharmaceutical.

8. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, McGrath et al., Blaimschein, Kitamura et al. and further in view of Lasher et al. (5720154).

Hoffman discloses an automated system for emptying contents of pharmaceutical containers (6, fig. 1), comprising a gripper unit (3, 12, fig. 1) for receiving and holding the container (6), a cutter (47, 48, fig. 5) for cutting the pharmaceutical container, a rotating unit (guide 79-80, fig. 9) operable with the gripper unit (12) that rotates at least a portion of the gripper unit to empty the contents of the container, a robot (see col. 3, lines 27-28; col. 6, lines 38-39) for placing the container in the gripper unit. Hoffman discloses a control unit (90, fig. 1), therefore a keyboard, control logic, a display and a processing unit are inherent part of the control unit.

Hoffman, as mentioned above discloses the cutter to cut the seal (aluminum foil) to empty the container. Hoffman does not disclose to cut at least one of the top, sidewall or bottom of the container to empty the container. However, Peres discloses that it is well known the art of emptying the containers to cut the top (95) of the container (see col. 4, lines 38-55) to empty the container. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the seal cutter of Hoffman with the top cutter of Peres to cut the top of the container to empty the container.

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for an electronic vision system (means for viewing). However, McGrath et al. teach an electronic vision system (3, fig. 20) for rejecting out of shape

containers from the conveyors (see col. 4, lines 37-67). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide vision system as taught by McGrath et al. in the automated system for emptying contents of Hoffman for rejecting out of shape containers from the conveyors.

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for an ultrasonic cutter. However, Blaimschein teaches an ultrasonic cutter to permit an economical and accurate cutting of work-pieces made of any desired polymers or fiber-reinforced polymers with a high efficiency and a low loss of material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ultrasonic cutter as taught by Blaimschein in the automated system for emptying contents of Hoffman to permit an economical and accurate cutting of work-pieces with a high efficiency and a low loss of material.

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for a sensor system to determine when the contents of the container are no longer being emptied. However, Kitamura et al. teaches sensor system (7, fig. 4; comprises a light emitter, see col. 6, lines 67-68; col. 7, lines 1-2) to determine the contents of funnel (4, fig. 4) are no longer being emptied to activate the scrapper assembly (8, fig. 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sensor system to determine when the contents of the container are no longer being emptied as taught by Kitamura et al. in the automated system for emptying contents of Hoffman to determine when the

contents of the container are no longer being emptied to activate the discharge chute traverse assembly to expose the bottle to the bottle discharge chute.

The modified system of Hoffman, as mentioned above, meets all the claimed limitations, except for an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers in a new bottle. However, Lasher et al. disclose an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers for a patient specific prescription orders (see abstract). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the automated pharmaceutical dispensing system as taught by Lasher et al. in the automated system for emptying contents of Hoffman to receive the contents of the pharmaceutical container emptied by the control system and dispense it for a patient specific order.

9. Claims 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claims 30, 37 and 87 above, and further in view of Brazell (5611378) and British Patent (2068829).

The modified system of Hoffman, as mentioned above, discloses all the claimed limitations of claims 100-103, except for providing vacuum source to collect the dust. However, Brazell and British Patent disclose that it is well known in the art to provide a vacuum source adjacent the cutter to facilitate dust-free cutting. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made

to provide the vacuum source as taught by Brazell and British Patent in the automated system for emptying contents of Hoffman to facilitate dust-free cutting.

10. Claim 104 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Peres, McGrath et al., Blaimschein, Kitamura et al., Lasher as applied to claim 93 above, and further in view of Brazell (5611378) and British Patent (2068829).

The modified system of Hoffman, as mentioned above, discloses all the claimed limitations of claim 104, except for providing vacuum source to collect the dust.

However, Brazell and British Patent disclose that it is well known in the art to provide a vacuum source adjacent the cutter to facilitate dust-free cutting. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the vacuum source as taught by Brazell and British Patent in the automated system for emptying contents of Hoffman to facilitate dust-free cutting.

11. Claim 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Peres, as applied to claim 37 above, and further in view of Lasher et al. (5720154).

The modified system of Hoffman, as mentioned above, meets all the claimed limitations of claim 105, except for an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers in a new bottle. However, Lasher et al. disclose an automated pharmaceutical dispensing system receiving the contents of the pharmaceutical container emptied by the control system and dispensing the contents of the pharmaceutical containers for a patient specific prescription orders

(see abstract). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the automated pharmaceutical dispensing system as taught by Lasher et al. in the automated system for emptying contents of Hoffman to receive the contents of the pharmaceutical container emptied by the control system and dispense it for a patient specific order.

Response to Arguments

12. Applicant's arguments filed 10/30/2007 have been fully considered but they are not persuasive. In response to Applicant's argument that Hoffman teaches away from destroying the bottle (e.g., cutting) and is, at least, concerned with contaminating the pharmaceutical. Note that Hoffman is mentioning U.S. Patent 4,573,853 which ruptures the vial and not cutting the container. Therefore, the method of rupturing the vial is entirely different than cutting the container. Further, "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007). Therefore, it would have been obvious to try a technique to cut the top of the container in order to empty the container.

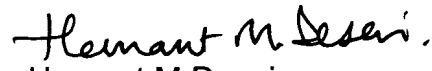
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shine et al. and Oleson et al. also disclose to cut the pharmaceutical container to empty the container.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M. Desai whose telephone number is (571) 272-4458. The examiner can normally be reached on 6:30 AM-5:00 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Hemant M Desai
Primary Examiner
Art Unit 3721

/hd/